REMARKS

Claim 19 has been amended in order to insert the limitation for the treatment of appetency disorders.

Claims 30-33, which are drawn to the non-elected subject matter of Group II, have been canceled without prejudice to the filing of a divisional application on the same.

Claims 1-18 and 34-38, which are directed to the subject matter which was elected for prosecution and allowed in U.S. application Serial No. 09/341,765, were canceled in the preliminary amendment filed on January 11, 2002. Claims 30-33 were canceled by the foregoing amendment. Claims 19-29 and 39 remain in the application.

Claims 19-23, 26-29 and 39 are rejected under 35 U.S.C. §103(a) as being unpatentable over Barth et al. (U.S. Patent No. 5,624,941) and Baroni et al. (U.S. Patent No. 5,488,151). In support of this rejection the Examiner has stated that:

> Barth et al. teach Applicants active agent, CB_1 receptor antagonist set forth in claims 19, 21 and 39 useful for the treatment of glaucoma. (abstract column 2, column 88, claim 27). Barth et al. also teach the dosage range of the CB1 receptor antagonist within the Applicants' range set forth in claims 27-29. (column 27, lines 10-35).
>
> Baroni et al. teach Applicants active agent β3 agonist set forth in claims 19, 23 and 26 useful for the treatment of glaucoma. (abstract, columns 1 and 2, column 2, lines 32-35, column 4, claim 1). Baroni et al. also teach the dosage range of the β3 agonist within the Applicants' range set forth in claims 27-29. (column 3, line 63-column 4, line 11).
>
> The claims differ from the cited references in claiming combination of CB1 receptor antagonist, and β_3 agonist, to treat glaucoma. To employ combinations of CB1 receptor antagonists and β_3 agonist to treat glaucoma would have been obvious because all the components are well known individually for treating glaucoma. It would be expected that the combination of components would treat glaucoma as well. The motivation for combining the components flows from their individually known common utility (see *In re Kerkhoven,* 205 USPQ 1069(CCPPA 1980)). Therefore, it would have been prima facie obvious to combine CB1 receptor antagonist, and β_3 agonist composition cojointly in a formulation to treat glaucoma.

This rejection is believed to be overcome and should be withdrawn in view of the above described amendments to the claims which are now directed to pharmaceutical compositions for the treatment of appetency disorders which are neither taught nor suggested by the disclosure of Barth et al. or Baroni et al. when taken alone or in combination.

Claims 19-22, 24 and 25 are rejected under 35 U.S.C. §103(a) as being unpatentable over Barth et al. (U.S. Patent No. 5,624,941) and Brazzell et al. (U.S. Patent No. 5,578,638). In support of this rejection the Examiner has stated that:

> Barth et al. teach Applicants active agent, CB_1 receptor antagonist set forth in claims 19 and 21 useful for the treatment of glaucoma. (abstract, column 2, column 88, claims 27).
>
> Brazzell et al. teach β_3 agonist (formula IV) useful for the treatment of glaucoma. (abstract, column 1, lines 7-15, columns 3-7).
>
> The claims differ from the cited references in claiming combination of CB1 receptor antagonist, and β_3 agonist, to treat glaucoma. To employ combinations of CB1 receptor antagonist and β_3 agonist to treat glaucoma would have been obvious because all the components are well know individually for treating glaucoma. It would be expected that the combination of components would treat glaucoma as well. The motivation for combining the components flows from their individually known common utility (se *In re Kerkhoven*, 205 USPQ 1069(CCPPA 1980)). Therefore, it would have been prima facie obvious to combine CB1 receptor antagonist, and β_3 agonist composition cojointly in a formulation to treat glaucoma.

This rejection is believed to be overcome and should be withdrawn in view of the above described amendments to the claims which are now directed to pharmaceutical compositions for the treatment of appetency disorders which are neither taught nor suggested by the disclosure of Barth et al. or Brazzell et al. when taken alone or in combination.

Claims 19-22, 24 and 25 are rejected under 35 U.S.C. §103(a) as being unpatentable over Barth et al. (U.S. Patent No. 5,624,941) and Cecchi et al. (U.S. Patent No. 5,130,339). In support of this rejection the Examiner has stated that:

> Barth et al. teach Applicants active agent, CB_1 receptor antagonist set forth in claims 19 and 21 useful for the treatment of glaucoma.

(abstract, column 2, column 88, claims 27).

Cecchi et al. teach β_3 agonist (formula V) useful for the treatment of glaucoma. (Abstract, column 1, lines 38-column 2, line 21, column 17, lines 4-12).

The claims differ from the cited references in claiming combination of CB1 receptor antagonist, and β_3 agonist, to treat glaucoma. To employ combinations of CB1 receptor antagonist and β_3 agonist to treat glaucoma would have been obvious because all the components are well know individually for treating glaucoma. It would be expected that the combination of components would treat glaucoma as well. The motivation for combining the components flows from their individually known common utility (se *In re Kerkhoven*, 205 USPQ 1069(CCPPA 1980)). Therefore, it would have been prima facie obvious to combine CB1 receptor antagonist, and β_3 agonist composition cojointly in a formulation to treat glaucoma.

This rejection is believed to be overcome and should be withdrawn in view of the above described amendments to the claims which are now directed to pharmaceutical compositions for the treatment of appetency disorders which are neither taught nor suggested by the disclosure of Barth et al. or Cecchi et al. when taken alone or in combination.

In view of the foregoing amendments and remarks, reconsideration and withdrawal of the rejection of (a) claims 19-23, 26-29 and 39 under 35 U.S.C. §103(a), (b) claims 19-22 and 24-25 under 35 U.S.C. §103(a) and (c) claims 19-22 and 25 under 35 U.S.C. §103(a), is requested and allowance of claims 19-29 and 39 is respectfully requested.

Respectfully submitted,

Date: December 1, 2003

Michael D. Alexander
Reg. No. 36,080

Address:
Sanofi-Synthelabo Inc.
9 Great Valley Parkway
P.O. Box 3026
Malvern, PA 19355
Tele: (610) 889-8802
Fax: (610) 889-8799